

Serial No. 10/810,994

Docket No. 10010594-2

## REMARKS

### I. PRELIMINARY REMARKS

Claim 14 has been amended. No claims have been added or canceled. Claims 1-19 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. DOUBLE PATENTING REJECTION

Claims 1-19 have been rejected under the judicially created doctrine of obviousness-type double patenting. Applicant respectfully submits that the obviousness-type double patenting rejection has been obviated by the Terminal Disclaimer attached hereto.<sup>1</sup>

### III. REJECTIONS UNDER 35 U.S.C. § 103

#### A. The Rejections

Claims 1-6 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 6,148,869 to Harding ("the Harding patent") and U.S. Patent No. 5,894,303 to Barr ("the Barr patent").

Claims 7 and 9 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 6,392,634 to Bowers ("the Bowers patent") and the Barr patent. Claim 8 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Bowers patent, the Barr patent, and

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<sup>1</sup> Applicant notes for the record that the filing of a Terminal Disclaimer serves only to remove the obviousness-type double patenting rejection and raises neither a presumption, nor an estoppel, with respect to the merits of the rejection. *See Quad Environmental Technologies v. Union Sanitation District*, 20 USPQ2d 1393, 1394-95 (Fed. Cir. 1991).

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U.S. Patent No. 6,163,326 to Klein ("the Klein patent"). Claims 10-13 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Bowers patent, the Barr patent and the Harding patent.

Claims 14 and 17-19 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Bowers patent and UK Pub. App. No. 2,139,762 to Prosenko ("the Prosenko application"). Claims 15 and 16 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Bowers patent, the Prosenko application and U.S. Patent No. 6,049,341 to Lin ("the Lin '341 patent").

The rejections under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

#### **B. Discussion Concerning Claims 1-6**

Independent claim 1 calls for a combination of elements comprising "a housing," "a first movement sensor ... adapted to sense movement of the housing relative to [a] surface," "a movable member, associated with one of the longitudinal ends of the housing such that the movable member will engage the surface in response to a placement of the peripheral device on the surface with the longitudinal axis perpendicular to the surface, and movable relative to the housing" and "a second movement sensor ... adapted to sense movement of one of the housing and the movable member relative to the other." The combinations defined by claims 2-5 include, *inter alia*, the elements recited in claim 1. The Harding and Barr patents fail to teach or suggest such combinations.

The Harding patent discloses a variety of input devices with multiple movable members that may be sensed to detect motion, and multiple buttons that may be pressed by the user. The input device 10 illustrated in Figures 1-4, which was referred to in the Office Action, includes a housing 12 with a first detection device 14 on the top surface and a second detection device 16 on the bottom surface. The first detection device 14 includes a ball 50 and encoders 52 and 54, while the second detection device

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16 includes a ball 28 and encoders 30 and 32. The top surface of the housing 12 also includes a plurality of buttons 18a-c. The purpose of the dual detection device arrangement is to allow the user to generate two multi-dimensional signals simultaneously. [Column 2, lines 33-51.]

In contrast to the invention defined by independent claim 1, neither of the Harding detection devices 14 and 16 are associated with a longitudinal end of the housing 12, and neither of the balls 28 and 50 will engage the surface upon which the input device is placed when the longitudinal axis 40 of the input device (Figure 5) is perpendicular to the surface. Instead, a cable 20 is located at one longitudinal end of the housing 12, and there is nothing at the other longitudinal end.

The Office Action seeks to remedy the above-identified deficiency in the Harding patent with the teachings of the Barr patent. Referring to Figures 1-4, the Barr patent discloses a vertically oriented computer mouse with a base 10, a ball 11 extending downwardly from the base, and a body 12 on top of the base. The body 12 is configured to conform to the palm of the user's hand. The Office Action has apparently taken the position that the teachings of the Barr patent would have motivated one of ordinary skill in the art to move the Harding ball 50 to the longitudinal end of the housing 12 where it would engage the surface upon which the input device is placed when the longitudinal axis 40 is perpendicular to the surface. Specifically, and quoting from column 3, lines 42-46 of the Barr patent, the Office Action asserts that the motivation for the modification would have been to provide a "computer input device [that] has **an external contour** which substantially conforms to the mean of the contour of the palm side surface of the hand, when the hand is in a relaxed, neutral condition, with the palm surface vertically disposed." [Office Action at page 4, emphasis added.] This position is traversed for a variety of reasons.

First and foremost, the Barr patent does not even remotely suggest that its teachings are applicable to an input device, such as that disclosed in the Harding patent, which has a dual detection device arrangement (i.e. two balls and two sets of encoders) that allows the user to generate two multi-dimensional signals simultaneously. [See MPEP § 2143.01.]

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Moreover, it is not at all clear what the Office Action considers the result of the purportedly obvious modification of the Harding input device 10 to be. Would the Harding input device 10 continue to have the box-like body 12, or would input device have the external contour (i.e. shape) of the Barr mouse? Additionally, if the Harding input device 10 was modified such that the body 12 was shaped like the Barr mouse, and the Harding ball 50 was moved to a longitudinal end of the body 12, where would the other ball (i.e. ball 28) be located? How would the user simultaneously rotate each ball? Would the user's ability to rotate both balls simultaneously be degraded by the purportedly obvious modification? ***Should the rejection be maintained, applicant respectfully requests that this issue be addressed in the next Office Action in order to clarify the issues for appeal.*** [See MPEP 707.07(f).]

In view of the forgoing, applicant respectfully submits that the Harding and Barr patents fail to create a *prima facie* case of obviousness with respect to the combination recited in independent claim 1. The rejection of claims 1-6 under 35 U.S.C. § 103 is, therefore, improper and should be withdrawn.

### C. Discussion Concerning Claims 7-13

Independent claim 7 is directed to a peripheral device comprising "a housing defining longitudinal ends and a longitudinal axis and including a plurality of ridges configured to augment a user's grip on the housing," "a movement sensor associated with one of the longitudinal ends of the housing such that the movement sensor will engage a surface in response to a placement of the peripheral device on the surface with the longitudinal axis perpendicular to the surface" and "a peripheral device mechanical connector." The respective devices defined by claims 8-13 include, *inter alia*, the elements recited in claim 7. The cited references fail to teach or suggest such devices.

The Bowers patent discloses a portable computer 10 with a removable pointing device 30, and a portable computer 10a with a removable pointing device 30a. Pointing device 30, which was referenced in the Office Action, is a "vertically invertable" device

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that functions as a trackball device (Figures 1 and 3) when attached to the computer 10 and functions as a mouse (Figures 2 and 4) when detached and flipped over. [Column 3, lines 50-65; column 4, lines 30-59; and column 5, lines 23-34.] To that end, a single ball 52 is positioned within a depression 48 on one side of the box-like housing 32. The top and bottom sides 38 and 40 of the housing 32 are generally planar and, together with the planar top and bottom sides of the computer base portion 12, define a continuous planar surface when the pointing device 30 inserted into the housing recess 58.

There are a variety of differences between the peripheral device defined by independent claim 7 and the peripheral device disclosed in the Bowers patent. For example, the Bowers pointing device 30 lacks (1) "a plurality of ridges that are configured to augment a user's grip on the housing" and (2) "a movement sensor associated with one of the longitudinal ends of the housing" of the housing 32. The Office Action has taken the position that the Barr patent remedies these deficiencies. More specifically, the Office Action appears to have taken the position that, in view of the Barr patent, it would have been obvious to change the box-like shape of the Bowers housing 32 to that of the Barr mouse, and to move the Bowers ball 52 to one of the longitudinal ends of the Bowers housing. [Office Action at pages 4 and 5.] This position is traversed for a variety of reasons.

For example, the Barr patent does not even remotely suggest that its teachings are applicable to pointing devices, such as those disclosed in the Bowers patent, that may be used to perform a trackball function when secured to a portable computer and a mouse function when detached from the portable computer.

More importantly, however, is the fact that the purportedly obvious modification proposed in the Office Action would substantially degrade two key aspects of the Bowers portable computer 10.<sup>2</sup> The first degraded aspect of the Bowers portable computer is functional. More specifically, the trackball function of the Bowers pointing device 30 (Figures 1 and 3) would be either destroyed or substantially degraded by the purportedly obvious modification. Moving the ball 52 to one of the longitudinal ends of

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<sup>2</sup> As noted in MPEP § 2143.01, modifications that would render a prior art device unsatisfactory for its intended purpose are not obvious.

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the pointing device housing 32 would result in the ball 52 being located either (1) within the computer housing 12 or (2) on the front side end of the computer 10, i.e. where the lead line from reference numeral 36 in Figure 1 contacts the housing 32, when the pointing device 30 is attached to the computer housing. Thus, the ball 52 would either be completely inaccessible, or the user would be forced to take one of his or her hands off the keyboard in order to manipulate the ball 52 at its "obvious" new position on the front end of the computer housing 12. The second degraded aspect of the Bowers portable computer is aesthetic. The changing the shape of the Bowers pointing device 30 to that of the Barr mouse would ruin the appearance of the Bowers computer 10, which has a planar bottom, and a planar transition from the computer top side 16 to the pointing device side 40, when the pointing device 30 is attached thereto. [Note Figure 1.]

As illustrated above, the Bowers and Barr patents fail to teach or suggest the combination of elements recited in independent claim 7, whether viewed alone or in combination. Applicant respectfully submits, therefore, that the rejection of claims 7 and 9 under 35 U.S.C. § 103 should be withdrawn.

Turning to the rejections of claims 8 and 10-13 under 35 U.S.C. § 103, applicant respectfully submits that the Klein and Harding patents fail to remedy the aforementioned deficiencies in the Bowers and Barr patents with respect to independent claim 7. As such, applicant respectfully submits that claims 8 and 10-13 are patentable for at least the same reasons as independent claim 7 and that the rejections of claims 8 and 10-13 under 35 U.S.C. § 103 should also be withdrawn.

#### D. Discussion Concerning Claims 14-19

Independent claim 14 calls for a combination of elements comprising "a portable computer including a display, a touch pad, **a keyboard adjacent to the touch pad and between the touch pad and the display**, a housing, and a computer mechanical connector" and "a peripheral device including a housing, a movement sensor, and a peripheral device mechanical connector configured to mate with the computer

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mechanical connector." The respective combinations defined by claims 15-19 include, *inter alia*, the elements recited in claim 14. The cited references fail to teach or suggest such combinations.

At the outset, applicant notes that the Bowers patent discloses two portable computer embodiments. In the first embodiment (Figure 1), the pointing device 30 functions as a trackball device when attached to the computer 10 and as a mouse when detached, as is discussed in detail above. In the second embodiment, the pointing device 30a functions as a touch pad (note pointing device touch pad 92) when attached to the computer 10a and as a mouse when detached.<sup>3</sup>

Despite the fact that there will be a touch pad 92 on the computer 10a when the pointing device 30a is attached to the computer 10a (Figure 7), the Office Action has taken the position that, in view of the teachings of the Prosenko application, it would have been obvious to modify the **other** Bowers computer, i.e. the computer 10 (Figure 1), by adding a touch pad. In other words, the Office Action has taken the questionable position that it would have been obvious to one of skill in the portable computer art to add a touch pad to a computer that will already have a trackball positioned below the keyboard when the pointing device 30 is attached thereto. Even more incredibly, the Office Action has taken the position that, **at the time the present invention was made**, it would have been obvious to a person in the portable computer art to place a touch pad between the keyboard and monitor of a portable computer instead of at the typical location on the other side of the keyboard. Such typical positioning is illustrated, for example, in Figure 7 of the Bowers patent.

The impropriety of the rejection notwithstanding, applicant respectfully submits that it has been obviated by the amendment above to independent claim 14. Even assuming for the sake of argument that the Prosenko application would have motivated one of skill in the art to add a touch pad to a portable computer that already has a trackball, the Prosenko application teaches placing the touch pad between keyboard and the display, not in the claimed location. Thus, even when improperly combined in

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<sup>3</sup> See column 7, lines 15-43. Additionally, Figure 7 includes a typographical error, i.e. reference numeral 72 should have been a "92."

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the manner proposed in the Office Action, the Bowers patent and Prosenko application fail to teach or suggest the combination of elements recited in independent claim 14. The rejection of claims 14 and 17-19 under 35 U.S.C. § 103 should, therefore, be withdrawn.

Turning to the rejections of claims 15 and 16 under 35 U.S.C. § 103, applicant respectfully submits that the Lin patent fails to remedy the aforementioned deficiencies in the Bowers patent and Prosenko application with respect to independent claim 14. As such, applicant respectfully submits that claims 15 and 16 are patentable for at least the same reasons as independent claim 14 and that the rejections of claims 15 and 16 under 35 U.S.C. § 103 should also be withdrawn.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

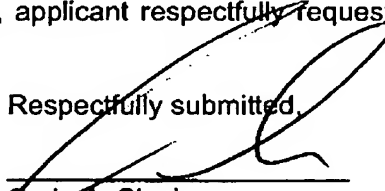
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Date

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